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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/707,140      | 11/24/2003  | JIMMY WU             | 11413-US-PA         | 1139             |

31561 7590 10/19/2005

JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE  
7 FLOOR-1, NO. 100  
ROOSEVELT ROAD, SECTION 2  
TAIPEI, 100  
TAIWAN

EXAMINER

SINGH, RAMNANDAN P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2646

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |              |  |
|------------------------------|-----------------|--------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s) |  |
|                              | 10/707,140      | WU ET AL.    |  |
|                              | Examiner        | Art Unit     |  |
|                              | Ramnandan Singh | 2646         |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4, 6-8 is/are rejected.
- 7) ☒ Claim(s) 2, 5 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on May 23, 2005 have been fully considered but they are not persuasive.

Applicant's argument---"More specifically Laturell fails to teach or suggest that POTS phone and IP phone are using the same key panel" on page 9.

Examiner's response--- Examiner respectfully disagrees. Laturell teaches a combined key panel comprising an IP phone keypad (1020) connected to an IP system (i.e. broadband access network (130)) and a POTS phone keypad (1045) connected to the POTS phone system wherein the combined key panel is controlled by a state/command interpreter (1070) [Fig. 10; Para: 0104-0105].

### **2. Status of Claims**

Claims 8 and 9 are amended.

Claims 1-9 are pending.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 3-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Laturell [US 20040052242 A1].

Regarding claim 1, Laturell teaches a dialing circuit apparatus incorporating an Internet Protocol (IP) phone and a plain Old Phone Service (POTS) phone shown in Fig. 10, comprising:

an IP phone system (i.e. broadband access network 130) for activating an IP phone (1020) according to an IP phone number;

a POTS phone system (140) for activating a POTS phone (1040) according to a POTS phone number;

an insulation system comprising a POTS/VoBB gateway 1065 and a cross-connect element 1085, electrically connected between the IP phone system (130) and the POTS phone system (140) for insulating the IP phone system from the POTS system; and

a key panel control (i.e. state/command interpreter (SCI) 1070) connected to the IP phone system and the POTS phone system;

wherein when the city power is on and a second phone number having a first format of the POTS phone number is inputted from the key panel, the second phone number is transferred by the insulating system and used as the POTS phone number to active the POTS phone, and the IP phone is disabled (i.e. XCE 1085);

wherein when the city power is off and a third phone number having a second format of the POTS phone number is inputted from the key panel, the IP phone is

turned off without a power supply from the city power, and the third phone number is used to active the POTS phone (see claims 7, 22) [ Para: 0126; Para: 0002-0005; 0009-0011; 0013-0014; 0036-0038; 0059; 0102-0112]; claims 1-12] .

Regarding claim 3, Laturell further teaches the dialing circuit apparatus, wherein the first format of the POTS phone number is the same as the second format of the POTS phone number (i.e. when a city power is on).

Regarding claim 4, Laturell further teaches the dialing circuit apparatus, wherein the first format of the POTS phone number is different from the second format of the POTS phone number [when the city power is Off. Claim 7].

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laturell as applied to claim 1 above, and further in view of Ahn et al [US 20030021261 A1] and further in view of Aponte et al [US 6,371,780 B1].

Regarding claim 6, although Laturell teaches the dialing circuit apparatus for the

IP phone system including an insulation system comprising a gateway system 1065 and cross-connect element 1085 shown in Fig. 10 [Para. 0102; 0106; 0108; 0111], no details about the functional structure of the IP phone system including a logic converting unit and main control unit are disclosed. So one of the ordinary skill in the art would have been motivated to seek any known circuit of an internet gateway to fulfill such details, such as Ahu et al.

Ahu et al teach an IP gateway of the IP phone system comprising a logic converting unit (35) connected to the IP phone keypad for converting the phone number to an IP dialing data signal; a main control unit (21) connected to the logic converting unit and an IP phone control unit connected to the main control unit for receiving the IP phone transmission signal and outputting an IP phone control signal [Figs. 2-4; Para: 0012-0013; 0015; 0035-0037; 0054; 0093].

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the internet gateway of Ahu et al with Laturell to enable the design of the invention.

Further, the combination of Laturell and Ahu et al does not teach expressly using a RJ-45 jack for connecting the phone line. However, it is well-known in the art.

Aponte et al teach using a RJ-45 port wherein the RJ-45 is connected to a phone company and to the IP phone control unit via an IP phone interface for activating an IP phone by the IP phone control signal [Figs. 3-5, 9, 12; col. 5, lines 15-65; col. 3, lines 17-60; col. 7, lines 21-64].

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the RJ-45 port of Aponte et al with the combine system of Ahu et al and Laturell to provide a robust functional way for users to evolve from telephony to IP phone systems [Aponte et al; col. 5, lines 23-28].

Claim 7 is essentially similar to claim 6 and is rejected for the reasons stated above.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laturell as applied to claim 1 above, and further in view of Cassista et al [US 20020007459 A1].

Regarding claim 8, Regarding claim 6, although Laturell teaches the dialing circuit apparatus comprising the insulation system comprising a gateway system 1065 and cross-connect element 1085 shown in Fig. 10 [Para. 0102; 0106; 0108; 0111], no details about the structure of the insulation circuit system are disclosed. So one of the ordinary skill in the art would have been motivated to seek any known circuit to insulate the circuit connection, such as Cassista et al.

Cassista et al not teach expressly the dialing circuit apparatus wherein the insulation system comprises a phototransistor circuit [Fig. 2; Para. 0055; 0113].

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the phototransistor circuit of Cassista et al with Laturell to enable the design of the invention.

***Allowable Subject Matter***

8. Claim 2, 5 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Examiner's Statement of Reasons for Allowance:

Claim 2 identifies the uniquely distinct feature of an integrated dialing system comprising a combined key panel, wherein the combined key panel includes: an IP phone keypad connected to the IP phone system; and a POTS phone keypad connected to the POTS phone system; wherein the key panel is disposed above the IP phone keypad and the POTS phone keypad, wherein each key of the key panel is disposed above a key of the IP phone keypad and above a key of the POTS phone keypad, whereby when a phone number is inputted, both the IP phone keypad and the



POTS phone keypad receive the phone number simultaneously. As such, claim 2 requires that both the IP phone keypad and the POTS phone keypad receive the phone number simultaneously when a phone number is inputted. While the closest prior art, Laturell [US 20040052242 A1], Ahu et al [US 20030021261 A1] and Phillips et al [US 20040176085 A1] each teach a POTS phone system and an IP phone system, Laturell using a state/command interpreter (SCI), Ahn et al using an internet telephony gateway system, and Phillips et al using a network interface device; none of them teach or suggest that when a phone number is inputted, both the IP phone keypad and the POTS phone keypad receive the phone number simultaneously. As such, the prior art, either singularly or in combination, fail to anticipate or render the above underlined limitation obvious. Therefore, claim 2 is allowable.

Claims 5 and 9 are allowable due to dependence from claim 2 .

### ***Conclusion***

**10. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramnandan Singh whose telephone number is (571) 272-7529. The examiner can normally be reached on M-TH (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramnandan Singh  
Examiner  
Art Unit 2646



**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**